

### Remarks

This Amendment is in response to the Office Action dated **November 22, 2004**.

In the Office Action, claims 1-3, 5-9 and 36-38 were rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-3, 5-7, 9 and 36 were rejected under 35 USC § 102(b) as anticipated by Vonesh et al. (WO 00/33770). Claims 1-3, 5-7, 9 and 36 were rejected under 35 U.S.C. 103(a) as being obvious over Vonesh et al. Claims 8 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vonesh et al. Claims 1-3, 5-9 36 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vrba (6,168,621). Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Vonesh et al.

Claims 4, 10-28, 30 and 33 were previously withdrawn. Applicant reserves the right to prosecute the subject matter of these claims in an application claiming priority from the instant application. Claims 1, 5, and 38 have been amended. No new matter has been added. Applicant addresses the rejections above under headings consistent with the rejection.

### 35 USC 112

Claims 1-3, 5-9 and 36-38 were rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Office Action stated that the term “cell” is unclear as to whether it refers to the openings within the stent wall or the physical material which bounds the openings. To clarify, “cells” refer to the physical material which bound the openings. Claim 5 has been amended to clarify the claim.

### 35 USC 102(b) and 35 USC 103(a) in light of Vonesh

Claims 1-3, 5-7, 9 and 36 were rejected under 35 USC § 102(b) as anticipated by Vonesh et al. (WO 00/33770) or in the alternative under 35 U.S.C. 103(a) as being obvious over Vonesh et al. Applicant disagrees with the rejection. Nonetheless in order to further prosecution, Applicant has amended claim 1 to recite “each opening extending straight through the sidewall of the stent”. Vonesh neither teaches nor suggests this limitation. In as much as the porous material of Vonesh has openings, there is no disclosure or suggestion that each opening extends straight through the sidewall of the stent. For at least this reason, independent claim 1

and claims 2-3 and 37 dependent thereof are patentable.

Applicant asserts that Vonesh does not teach or suggest the limitation of amended claim 5 which recites in part “the balloon expandable material and the self-expanding material do not overlap one another in a radial direction”. Vonesh neither teaches nor suggests this limitation. In fact, Vonesh teaches the opposite; the balloon expandable portions of Vonesh are actually constructed of both balloon expandable material and self-expanding material as balloon expandable material is merely disposed about a self-expanding portion. For at least this reason, independent claim 5 and claims 6-7 and 9 dependent thereof overcome both the 102(b) and 103(a) rejection over Vonesh et al.

Applicant respectfully requests that the 102(b) rejection and the alternative 103(a) rejection in light of Vonesh be withdrawn.

### **35 USC 103(a) in light of Vonesh**

Claims 8 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vonesh et al. Claim 5 is believed to be in condition for allowance. Claim 8 is dependent upon claim 5 and is believed to be allowable for at least the reason that it claims dependency on independent claim 5. Claim 1 is believed to be in condition for allowance.

Claim 37 is dependent upon claim 1 and is believed to be allowable for at least the reason that it claims dependency on independent claim 1. Furthermore, in as much as Vonesh may have a stent apparatus with balloon expandable qualities, 50% of the stent is not made from one piece balloon expandable metal. As stated above, the stent of Vonesh teaches a self expanding stent having balloon expandable material disposed about selected portions of the stent. Therefore, rather than teaching a one piece construction, the balloon expandable portions of the stent apparatus of Vonesh are of a multiple piece construction in that the balloon expandable portions are constructed of both a self expanding stent component and a balloon expandable material component disposed about the self expanding stent component. Applicant respectfully requests that the 103(a) rejection in light of Vonesh be withdrawn.

### **35 USC 103(a) in light of Vrba**

Claims 1-3, 5-9 36 and 37 were rejected under 35 U.S.C. 103(a) as being

unpatentable over Vrba (6,168,621). Claim 1 has been amended to recite in part “at least one of the balloon expandable cells formed entirely of non-self-expanding material”. Vrba neither teaches nor suggests this limitation. Instead, the balloon expandable cells of Vrba include self-expanding material. For at least this reason, independent claim 1 and claims 2-3 and 36-37 dependent thereof overcome the 103(a) rejection in light of Vrba.

Claim 5 has been amended to recite in part that “the balloon expandable cells formed of only non-self-expanding material”. Vrba neither teaches nor suggests this limitation. Instead, the balloon expandable cells of Vrba include self-expanding material. For at least this reason, independent claim 5 and claims 6-9 dependent thereof overcome the 103(a) rejection in light of Vrba.

Applicant respectfully requests that the 103(a) rejection in light of Vrba be withdrawn.

#### **35 USC 102(b)**

Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Vonesh et al. The Office Action characterized each section 58 of Fig. 9 of Vonesh as having a plurality of segments (i.e. a top half of one section and a bottom half of another section). Applicant has amended claim 38 to recites in part “each self-expanding segment being non-abutting to any other self-expanding segment, some of the plurality of self-expanding segments being longitudinally and circumferentially offset from one another”. To the extent that Vonesh, for the sake of argument, teaches self-expanding segments as characterized in the Office Action, the self-expanding segments abut one another, contrary to amended claim 38. Applicant respectfully requests that the rejection be withdrawn.

**Conclusion**

In light of the above comments, claims 1-3, 5-9 and 36-38 are believed to be in condition for allowance. Notification to that effect is respectfully requested.

Respectfully submitted,

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